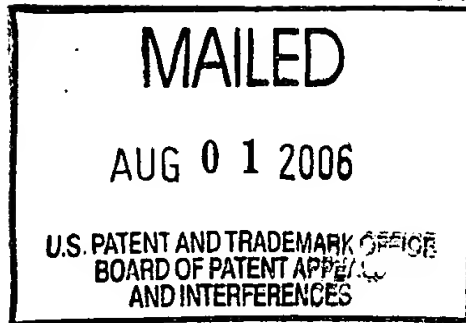


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte TETSURO MOTOYAMA

Application 09/108,705

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on July 25, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that appellant filed an Appeal Brief on July 6, 2001. In response, an Examiner's Answer was mailed on September 25, 2001.

Section § 1208.02 of the Manual of Patent Examining

Procedure (MPEP) (7th Ed., Rev. 1, February 2000) states:

Requirements for Examiner's Answer

The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

. . . .

(8) Claims Appealed. A statement of whether the copy of the appealed claims contained in the appendix to the brief is correct and, if not, a correct copy of any incorrect claim.

(9) References of Record. A listing of the references of record relied on, and, in the case of nonpatent references, the relevant page or pages.

(10) Grounds of Rejection. For each ground of rejection applicable to the appealed claims, an explanation of the ground of rejection, or reference to a final rejection or other single prior action for a clear exposition of the rejection.

It should be noted that page 3 is missing from the Examiner's Answer mailed September 25, 2001. The above three categories might appear on the missing page. If not, correction is required.

In addition, Information Disclosure Statements were filed on January 1, 1998, June 16, 2000, April 9, 2001, July 28, 2003,¹ and January 23, 2004 (partially considered – only Foreign Patent Document considered). It is not apparent from the record whether the examiner considered the statements submitted or notified appellant regarding why his submissions did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98. A communication-notifying appellant of the Primary Examiner's decision is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

1) to obtain a copy of missing page 3 for the Examiner's

Answer mailed September 25, 2001, in order to complete the record;

2) if appropriate, for submission of a revised Examiner's


Answer which includes the following sections: (8) Claims Appealed;

(9) References of Record; and (10) Grounds of Rejection;

¹ The deficiency regarding this IDS was previously noted by an ORDER REMANDING TO EXAMINER mailed September 30, 2003. It should be noted that the filing date of the IDS was incorrectly listed as September 28, 2003. The proper date should have been July 28, 2003. Additionally, according to the Office communication mailed February 26, 2004, "[t]he request for considering the Information Disclosure Statement filed on September 28, 2003 [sic, July 28, 2003] is considered. A copy of the IDS will be mailed to the Application [sic, Applicant]." We were unable to find a copy of the above-noted IDS in the IFW.

- 3) for consideration of the IDSs filed January 1, 1998, June 16, 2000, April 9, 2001, and January 23, 2004 (Other References section only);
- 4) to furnish a copy of the approved IDS mailed January 23, 2004 (as noted by the Office communication mailed February 26, 2004); and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 
DALE M. SHAW
Deputy Chief Appeal Administrator
(571) 272-9797

DMS:psb

C. Irvin McClelland
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314